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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/783,668

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Gabriel Santos

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MOTOROLA INC

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EXAMINER

PRONE, JASON D

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 05/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/783,668

Applicant(s)

SANTOS ET AL.

Examiner

Jason Prone

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 7, 8, and 10-13 are rejected, as best understood, under 35 U.S.C. 102(b) as being anticipated by Coleman (3,675,524).

In regards to claim 1, Coleman discloses the same invention including a means for holding a work piece (23), a cutting means (17 and 27) comprising at least one blade (17), the blade passes across at least one surface of the work piece (Fig. 2),

In regards to claim 2, Coleman discloses the cutting means further comprises a leveling means (27).

In regards to claim 3, Coleman discloses the amount of insertion is limited by the leveling means (Fig. 1).

In regards to claim 7, Coleman discloses a sliding member coupled to the cutting means (12) and the sliding member is mounted on rails (Fig. 3).

In regards to claim 8, Coleman discloses the sliding member is coupled to a lever (13).

In regards to claim 10, Coleman discloses a threaded member coupled to the sliding member (7) and the threaded member passes through a fixed stop (5).

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In regards to claim 11, Coleman discloses a threaded stop disposed about the threaded member (8) such that the fixed adjustment stop is disposed between the sliding member and the threaded stop (Fig. 2).

In regards to claim 12, Coleman discloses travel of the cutting means is adjustable by twisting the threaded stop (8).

In regards to claim 13, Coleman discloses the cutting means is electrically isolated from the means for holding a work piece (Fig. 2).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman in view of Makeev et al. (4,077,287). Coleman discloses the invention but fails to disclose a magnet mounted below the cutting means. Makeev et al. teaches a magnet below the cutting means (39 Column 10, lines 20-25). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Coleman with a magnet, as taught by Makeev et al., to prevent the cut pieces from traveling all over.

5. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman in view of Diskin (5,135,208). Coleman discloses the invention but fails to disclose the means for holding includes a fixed block and a spring-loaded belt. Diskin

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teaches a means for holding that includes a fixed block (22) and a spring-loaded (64) belt (52). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Coleman with a fixed block and a spring-loaded belt, as taught by Diskin, to allow the holding means to hold an alternate shaped work piece.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman in view of Matych (1,164,658). Coleman discloses the invention but fails to disclose the lever is rotatably connected to the sliding member by way of a gear assembly. Matych teaches a lever (27) that is rotatably connected to the sliding member (24) by way of a gear assembly (Figs. 3 and 4). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Coleman with a gear assembly, as taught by Matych, to allow for a more precise method of moving the sliding member.

7. Claims 15, 16, and 18 are rejected, as best understood, under 35 U.S.C. 103(a) as being unpatentable over Coleman in view of Diskin. Coleman discloses the invention including a base member (1), a fixed block coupled to the base member (23), a moveable cutting means comprising at least one blade (17), a leveling means (27), and the cutting means is electrically isolated (17).

However, Coleman fails to disclose the fixed block includes a recess for holding the work piece, a spring loaded moveable belt, and the belt and the recess form a closed loop. Diskin teaches a fixed block (22) with a recess for holding the work piece (30), a spring-loaded (64) moveable belt (52), and the belt and the recess form a closed

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loop (Fig. 5). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Coleman with a fixed block and a spring-loaded belt, as taught by Diskin, to allow the holding means to hold an alternate shaped work piece.

8. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman in view of Diskin as applied to claim 15 above, and further in view of Makeev et al. Coleman and Diskin disclose the invention but fail to disclose a magnet disposed below the cutting means. Makeev et al. teaches a magnet below the cutting means (39 Column 10, lines 20-25). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Coleman in view of Diskin with a magnet, as taught by Makeev et al., to prevent the cut pieces from traveling all over.

Response to Arguments

9. Applicant's arguments filed 10 April 2006 have been fully considered but they are not persuasive. Applicant is not positively claiming the work piece; therefore, the newly added subject matter to the independent claims is considered an intended use. The claimed invention is a "shaver" only and not the combination of the work piece (battery with debris) and the "shaver". Any item that is being cut incorporates debris. The term debris is so broad that it is interpreted to mean any item that is cut off of another item. In response to applicant's argument that the applied references do not disclose a battery with debris, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to

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patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is (571) 272-4513. The examiner can normally be reached on 7:30-5:00, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 26, 2006



Patent Examiner
Jason Prone
Art Unit 3724
T.C. 3700